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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,249	07/23/2003	David Kingsolver	1327-001	9300
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HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER RAMOS FELICIANO, ELISEO	
			ART UNIT 2687	PAPER NUMBER

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,249

Applicant(s)

KINGSOLVER ET AL.

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on October 6, 2005. These drawings are not acceptable.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "decoder 120" (page 9, line 10). Figure 1 shows "decoder 110"; this appears to be a typographical error. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Previous objection to the claims is withdrawn in view of Applicant's amendment filed October 6, 2005.

### ***Claim Rejections - 35 USC § 112 – 2<sup>nd</sup> paragraph***

4. Previous rejection to claim 18 under 35 USC § 112, second paragraph, is withdrawn in view of Applicant's amendment filed October 6, 2005.
5. *Nevertheless, Applicant's amendment has introduced new problems treated as follows:*

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding **claim 1**, it is not clear how the system can be practiced in reverse.

9. **Claims 2-10** depend on *claim 1*; therefore they contain same problem.

***Claim Rejections - 35 USC § 112 – 1<sup>st</sup> paragraph***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 1-18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. **Claim 1** now requires "(e) wherein the system can be practiced in reverse". This is subject matter which was not described in the original specification. Applicant has neither pointed out the particular section of the original disclosure that support such limitation.

13. **Claims 2-10** depend on *claim 1*; therefore they contain same problem just explained.

14. **Claim 11** now requires "(f) repeating steps (a) through (e) in reverse". This is subject matter which was not described in the original specification. Applicant has neither pointed out

the particular section of the original disclosure that support such limitation.

15. **Claims 12-18** depend on *claim 11*; therefore they contain same problem just explained.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 1-3, 5, 7-13, and 16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Patent Number 6,138,158).

Regarding **claim 11**, Boyle et al. discloses a method for conducting two-way radio communication (Figures 1-4), said method comprising:

(a) transmitting a signal code (character set / key sequence / web address) and two-way radio communication from a first two-way radio (client / mobile phone – 106) to a base/repeater station (102, 108);

(b) decoding said signal code and correlating said decoded signal code to one or more internet addresses (URL / web address / IP address – column 8, line 37; column 9, line 49 to column 10, line 17; Figure 5);

(c) establishing a computer network link (see links in Figures 1-4; for example 114) between said base/repeater station and a target station (server – 112, 110; column 5, lines 4-23) through said internet address;

(d) exchanging real time voice and/or data communications over said computer network link (for example, data: HDTP/HTTP request – column 6, line 30 to column 7, line 39);

(e) transmitting said real time voice and/or data communications from said target station to a second two-way radio (for example, data: HTTP response – column 6, line 30 to column 7, line 39). See column 4, line 58 to column 7, line 51.

However, Boyle et al. fails to specifically teach "(f) repeating steps (a) through (e) in reverse".

Nevertheless, it has been held that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946).

Regarding **claim 12**, Boyle et al. discloses everything claimed as applied above (see *claim 11*). In addition, Boyle et al. discloses wherein said signal code is selected on a keypad device (column 6, lines 45-48).

Regarding **claim 13**, Boyle et al. discloses everything claimed as applied above (see *claim 11*). In addition, Boyle et al. discloses wherein said signal code is selected on a channel selector device (HDML hierarchical pages – column 7, lines 15-20; column 9, line 60 to column 10, line 17).

Regarding **claims 16-17**, Boyle et al. discloses everything claimed as applied above (see *claim 11*). In addition, Boyle et al. discloses wherein said signal code is correlated to one or more internet addresses associated with a target station by a radio controller using a computer based relational data base and a suitable decoder (column 9, line 49 to column 10, line 17; Figure 5). The Internet address is an IP address (column 8, line 37).

Regarding **claim 18**, Boyle et al. discloses everything claimed as applied above (see *claim 11*). In addition, Boyle et al. discloses wherein said bi-directional computer network link

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with one or more target base/repeater stations is established by a voice communication system selected from the group consisting of trunked, conventional radio system or a combination thereof. (For example, the link includes at least a conventional radio system as depicted in 120 – Figure 1: CDMA, GSM, TDMA, etc.)

Regarding **claim 1**, it is corresponding obvious variation claim of *claim 11*; therefore, same reasons shown above are incorporated herein. For clarification, *in view of 35 USC § 112, second paragraph, rejection above*, Boyle et al. discloses a system for two-way radio communication (Figures 1-4) comprising:

(a) a first two-way radio (client / mobile phone – 106) comprising: (i) a means for exchanging a two-way radio communication (transceiver of the device – column 5, lines 4-10) with a base/repeater station (102, 108); and (ii) a means for selecting (keypad) and transmitting (transceiver; e.g. 336) a signal code to said base/repeater station;

(b) a base/repeater station (102, 108) comprising: (i) a base/repeater station decoder for decoding the signal code from said first two-way radio into a signal that can be recognized by a base/repeater station controller and transferring said signal to said base/repeater station controller; and (ii) wherein said base/repeater station controller comprises a means for receiving said decoded signal from said base/repeater station decoder and correlating said decoded signal to one or more internet addresses associated with one or more target base/repeater stations and a means for establishing a bi-directional computer network link with said at least one target station for real time voice and/or data communications;

(c) at least one target station (server – 112, 110; column 5, lines 4-23) comprising: (i) a target station controller a means for establishing a bi-directional computer network link with said

base/repeater station for real time voice and/or data communications from said base/repeater station controller and comprising a means for transferring a signal comprising said real time voice and/or data communications to a target station encoder; and (ii) wherein said target station encoder receives said real time voice and/or data communications from said target station controller and encodes said signal into a signal code that can be recognized by a second two-way radio; and

(d) at least one second two-way radio (304, 306) comprising a means for exchanging two-way radio communications with a target station and means for receiving said signal code from said target station encoder (Figure 3: 302 is the first two-way radio depicted as 106 in Figure 1; column 5, lines 10-12; 304 and 306 are the at least one second two-way radio; column 8, lines 16-20; all of the communicate via airtel 102 depicted in Figures 1-3).

However, Boyle et al. fails to specifically teach "(e) wherein the system can be practiced in reverse".

Nevertheless, mere reversal of parts has been held to be an obvious expedient. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). In addition, it has been held that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946).

Regarding **claim 2**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said signal code is selected on a keypad device (column 6, lines 45-48).

Regarding **claim 3**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said signal code is selected on a channel selector



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device (HDML hierarchical pages – column 7, lines 15-20; column 9, line 60 to column 10, line 17).

Regarding **claim 5**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said signaling method comprises a modulated RF carrier (Figure 1: CDMA, GSM, TDMA, etc.)

Regarding **claims 7-8**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said base/repeater station means for correlating the signal to one or more internet addresses associated with a target station is a computer based radio controller comprising a relational data base (118/114) (column 9, line 49 to column 10, line 17; Figure 5). The Internet address is an IP address (column 8, line 37).

Regarding **claim 9**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said bi-directional computer network link with one or more target base/repeater stations is established by a voice communication system selected from the group consisting of trunked, conventional radio system or a combination thereof. (For example, the link includes at least a conventional radio system as depicted in 120 – Figure 1: CDMA, GSM, TDMA, etc.)

Regarding **claim 10**, Boyle et al. discloses everything claimed as applied above (see *claim 1*). In addition, Boyle et al. discloses wherein said at least one secondary two-way radio is further comprised of a means for transmitting a signal code (all features described for 302/106 are applicable to 304/306 as well; Figure 3: 302 is the first two-way radio depicted as 106 in Figure 1; column 5, lines 10-12; 304 and 306 are the at least one second two-way radio; column 8, lines 16-20; all of the communicate via airnet 102 depicted in Figures 1-3).

18. **Claims 4, 6, and 14-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Patent Number 6,138,158) in view of the Admitted Prior Art (disclosed on page 2, second full paragraph and page 6, second full paragraph of the present specification).

Regarding **claims 4, 6, and 14-15**, Boyle et al. discloses everything claimed as applied above (see *claims 1 and 11*). However, Boyle et al. fails to specifically disclose DCS, CTCSS, DTMF, or any combination thereof, nor LTR, MPT-1327, EDACS, or any combination thereof as claimed.

However, these conventional methods/protocols are particular requirements of particular systems as shown by the prior art admitted by applicant on page 2, second full paragraph and page 6, second full paragraph of the present specification ("Admitted Prior Art"). Use of any of these conventional methods/protocols is obvious expedient as an engineering design choice.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use DCS, CTCSS, or DTMF, and/or LTR, MPT-1327, or EDACS, as claimed for the selection of any of these conventional methods/protocols is an engineering design choice as particular requirements of particular systems.

#### ***Response to Arguments***

19. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ELISEO RAMOS-FELICIANO**  
**PATENT EXAMINER**

ERF/erf  
December 20, 2005